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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,041	04/26/2001	Koji Yamazaki	35.C15344	6508

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 04/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,041

Applicant(s)

YAMAZAKI ET AL.

Examiner

Christopher D RoDee

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 24 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 24 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 11.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 March 2003 has been entered.

Response to Amendment

The recent amendment to specification page 36, beginning at line 13 is improper because the clean copy contains brackets and underlining for material to be added or deleted in the formula. A new copy of the paragraph should be submitted without bracketing and underlining.

The change in the claims from deposition of a toner to providing a toner are seen as equivalent expressions because the toner would have to be deposited to provide an image.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In the recent amendment applicants have changed a limitation from "a kinetic frictional deviation factor" to "a kinetic frictional deviation coefficient". It appears to the examiner that the term "factor" and "coefficient" have the same meaning in the manner used. However, there is not correspondence between this feature because of the claim amendment

Art Unit: 1756

(e.g., spec. p. 12, bottom). The specification should be amended at each reference to this feature so there is clear antecedent basis for the claims as presented.

Similarly the claims have been amended to refer to "the intermediate image-transfer element" rather than a "the intermediate image-transfer member". It appears that "element" and "member" have the same meaning but applicants must have antecedent basis for the current claim limitations in the specification as filed. Suitable specification amendments are required.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 15 and 16 have been renumbered as claims 24 and 25.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14, 24, and 25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims have been amended to specify the photosensitive member and the intermediate image-transfer element in claim 1 and the plurality of photosensitive members and the recording sheet in claim 8 are brought into contact at a contact line rather than a contact face as previously presented. Giving the words their usual and customary meaning in light of the specification disclosure, a line is a one-dimensional series of points while a face is a two dimensional area, basically a planar surface. The specification as originally filed is consistent with the claims as originally filed in that the noted contact creates a face. The specification states that the contact has a breadth of several millimeters (p. 9, l. 10-11; p. 13, l. 3). If applicants have basis for the amendment as filed they are asked to refer the Examiner to the pertinent portions of the specification.

Claim 24 specifies the cylindrical intermediate image transfer element as a belt. Basis for this amendment is asserted as being present at specification page 70, lines 11-13. This passage discusses the apparatus present in Figure 11. As readily apparent in the figure, the belt **20** is clearly not in a cylindrical shape. The new claim that specifies the transfer element as a cylindrical shaped belt is without basis in the specification as filed and contains new matter. The Examiner suggests that claim 24 be drafted as an independent claim that removes reference to a cylindrical shape for the intermediate transfer belt.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 703 308-2465. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703 308-2464. The fax phone numbers for the

Application/Control Number: 09/842,041

Page 5

Art Unit: 1756

organization where this application or proceeding is assigned are 703 872-9310 for regular communications and 703 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0661.

cdr
March 31, 2003


CHRISTOPHER RODEE
PRIMARY EXAMINER